

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN S. KELCHER

Appeal No. 1999-1899
Application No. 08/932,090

ON BRIEF

Before FRANKFORT, NASE, and LAZARUS, Administrative Patent Judges.

LAZARUS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2 and 4 through 15. Claim 3, the only other claim pending in the application, has been indicated to contain allowable subject matter, but is objected to as depending from a non-allowed claim.

We affirm and add new grounds of rejection under

37 CFR § 1.196(b).

THE INVENTION

The appellant's invention relates to an apparatus into which particulate material may be charged for further processing, conveying, handling or storage, commonly referred to as bag dump stations (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief. Claim 1, the sole independent claim on appeal, reads as follows:

1. An apparatus into which particulate material may be charged for further handling, comprising:

a housing having a support wall including a primary inlet through which said particulate material may be charged, producing portions of settling and airborne particles of said material within and outside said housing, and at least one secondary inlet, and an outlet through which said particulate material may be discharged;

a filter unit having an inlet communicating with an interior of said housing; and

means for producing an airflow through said primary and secondary inlets, said housing and said filter unit whereby ambient air will be caused to flow from outside the housing directly into said primary and secondary inlets, leading to the interior of said housing and said filter unit, entraining airborne particles disposed within and outside said housing which further are caused to be filtered out by said filter unit to be discharged through said housing outlet.

THE PRIOR ART

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Ruemelin	1,743,934	Jan. 14, 1930
Heyl	4,889,452	Dec. 26, 1989
Oldham et al. (Oldham)	5,097,750	Mar. 24, 1992
Gueyrard	FR 2 275 384	Jan. 16, 1976 ¹
	(published French patent application)	

THE REJECTIONS

Claims 1, 2 and 4 through 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Heyl taken together with Ruemelin.

Claims 1, 2 and 4 through 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Oldham taken together with Ruemelin.

¹ In determining the teachings of Gueyrard, we will rely on the translation provided by the PTO. A copy of the translation is attached hereto for appellant's convenience.

Claims 1, 2 and 4 through 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gueyrard taken together with Ruemelin.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 12, mailed March 17, 1999) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 11, filed January 21, 1999) and reply brief (Paper No. 13, filed April 15, 1999) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review we make the determinations which follow.

--The 35 U.S.C. § 103 rejection over Heyl and Ruemelin--

We shall sustain this rejection.

Heyl discloses an "apparatus for receiving particulate matter from a container by which the matter was transported and filtering from the ambient atmosphere dust particles produced by transfer of the particulate matter to the receiving apparatus" (column 1, lines 20-24). Heyl's bag dump station (110), seen in Figures 8 and 9, comprises a hopper (112) for receiving particulate material transferred thereto (column 6, lines 57-59), a filter mechanism (118), a centrifugal blower (120) establishing an airflow as shown by the arrow (210) in Figure 9 and a grate (124) covering the face of the hopper. As a result of the airflow or pneumatic path (210), the larger and heavier particles will drop directly into the hopper (112), and the remaining particles will be dispersed over filter elements (130) (column 7, lines 51-55).

The examiner states that "Heyl is silent as to at least one secondary inlet" (answer, page 4) and then argues, in

effect, that it would have been obvious to one of ordinary skill in the art at the time of the invention to substitute structure from Ruemelin's apparatus in Heyl so as to result in an apparatus as claimed by appellant's claim 1 (answer, page 5). Appellant argues that the combination of Heyl and Ruemelin does not meet the language of claim 1 that "... ambient air will be caused to flow from outside the housing directly into said primary and secondary inlets..." (brief, page 13). We do not agree with the examiner or with the appellant.

Based on our analysis and review of Heyl and claim 1, it is our opinion that there is no difference between the limitations of claim 1 on appeal and the teaching of Heyl.²

The examiner's conclusion that the combination of Heyl and Ruemelin is obvious is, in our view, based solely on hindsight.³ Nothing in Heyl or Ruemelin teaches or suggests

² After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

³ Obviousness may not be established using hindsight or in view of the

modifying Heyl in the manner suggested by the examiner. Ruemelin's apparatus is for dust separation from a current of air (page 1, line 4) into an inlet (13) (Fig. 1). In contrast, Heyl's bag dump station (110) has a hopper (112) for receiving particulate material from a container (column 1, lines 19-20) which, as is apparent from Fig. 9, is open to ambient air. The examiner's reason for modifying Heyl "so that smaller airborne particles of the apparatus of Heyl are discharged through at least one secondary inlet while larger particles are discharged through a primary inlet" (answer, page 5) would appear to provide no benefit over the structure taught by Heyl. It is our opinion that the examiner's rejection relies on impermissible hindsight and it would not have been obvious to use Ruemelin's teaching of structure for directing a current of dust-laden air in Heyl which receives particulate material from a container.

However, we also disagree with the appellant's argument

teachings or suggestions of the inventor. See Para-Ordnance Mfg. v. SGS Importers Int'l, 73 F.3d 1085, 1087, 37 USPQ 2d 1237, 1239 (Fed. Cir. 1995) (citing W. L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)).

that the limitations of claim 1 are not taught by the applied prior art. Heyl teaches all of the limitations of appellant's claim 1 and, with regard to the claimed primary and secondary inlets, it is our determination that one of ordinary skill in the art would understand that Heyl's grate (124) (Fig. 8 and column 7, line 45) consists of a plurality of openings/inlets wherein the openings/inlets located in the center area of the grate can be considered to be a primary inlet in that they would likely pass more particulate material than the openings/inlets at the periphery of the grate, which peripheral openings/inlets can be considered to constitute a secondary inlet. As to the appellant's argument that the combination (of Heyl and Ruemelin) does not meet the claim language that "... ambient air will be caused to flow from outside the housing directly into said primary and secondary inlets..." (brief, page 13), we note that the arrow (210), in Figure 9 of Heyl, illustrates the path of ambient air from outside the apparatus through the plurality of openings in the grate (124) (i.e., the primary and secondary inlets) into the housing, thus this claimed limitation is satisfied by Heyl.

As noted above, Heyl does teach all the limitations of claim 1. A disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for "anticipation is the epitome of obviousness." Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). See also In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974). Thus, we affirm the examiner's rejection of appealed claim 1 under 35 U.S.C. § 103 as being unpatentable over Heyl taken together with Ruemelin. However, for reasons explained infra, we have denominated our affirmance a new ground of rejection under 37 CFR § 1.196(b).

In accordance with 37 CFR § 1.192(c)(7), we have selected claim 1 as the representative claim from the appellant's grouping (brief, page 10) of claims 1, 2 and 4 through 15 and decide the appeal on this rejection on the basis of this claim alone. Accordingly, we also sustain the examiner's rejection of claims 2 and 4 through 15 under 35 U.S.C. § 103 based on Heyl and Ruemelin, since these claims fall with claim 1.

--The 35 U.S.C. § 103 rejection over Oldham and Ruemelin--

We shall not sustain this rejection.

The examiner states that Oldham is "silent as to an outlet through which particulate material may be discharged and at least one secondary inlet" (answer, page 5). In the examiner's opinion it would have been obvious to one of ordinary skill in the art at the time of the invention to, in effect, substitute inlet structure from Ruemelin's apparatus into Oldham to yield an apparatus as claimed by appellant's claim 1 (answer, page 6).

In rejecting claims under 35 U.S.C. ' 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art. See In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993). If

the examiner fails to establish a prima facie case, the rejection is improper and will

be overturned. See In re Fine, 837 F.2d 1071, 1076, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

Oldham's portable disposal system for solid and aerosol waste (column 1, lines 6-9) is open to ambient air (Figs 1 and 2) and operates such that the filter (26) removes aerosol contaminants and the bag (32) receives solid waste (column 2, lines 33-42). We do not find any teaching or suggestion in either Oldham or Ruemelin to support the examiner's reasoning for modifying Oldham "so that airflow in the apparatus of Oldham flows from a point outside the housing of Oldham directly through the primary and at least one secondary inlet of Oldham into the interior of the housing, and so that smaller airborne particles of the apparatus of Oldham are discharged through at least one secondary inlet while larger particles are discharged through a primary inlet" (answer, page 6). Hence, it is our opinion that the examiner's rejection is based on hindsight reconstruction of the subject

matter of the appellant's claim 1, and for this reason we do not sustain the examiner's rejection of appealed claim 1, or of claims 2 and 4 through 15 which depend from claim 1, under 35 U.S.C. § 103 as being unpatentable over Oldham taken together with Ruemelin.

--The 35 U.S.C. § 103 rejection over Gueyrard and Ruemelin--

We shall sustain this rejection.

Gueyrard discloses an apparatus for receiving poured product which may be granular, pulverized, or dust, and including an automatic dust separator (page 1). Gueyrard discloses (Fig. 1) a charging opening in a housing with a safety grid (3), a suction fan (7), filters (6), a suction chamber (4) and a cone (hopper) (8) for receiving the product (page 4). It is our view that the larger material poured on Gueyrard 's safety grid (3) falls into the cone while air flows (Fig. 1) from outside the housing through the safety grid (3) then through the filters (6) and out through the suction fan (7) leaving particles trapped in the filters (6).

Gueyrard's safety grid (3) (Fig. 1), like Heyl's grating (124), teaches openings/inlets in the center which are primary in that they would likely pass more particulate material than the secondary openings/inlets nearer the periphery of the safety grid.

The examiner states that the "French patent [Gueyrard] is silent as to at least one secondary inlet" (answer, page 7) and then argues, in effect, that it would have been obvious to someone of ordinary skill in the art at the time of the invention to substitute structure from Ruemelin's apparatus in Gueyrard so as to result in an apparatus as claimed by appellant's claim 1 (answer, page 8). The appellant's only argument is that "[e]ven though the primary reference is different, the secondary reference and the motivation for combining are overwhelmingly the same" [as Heyl taken together with Ruemelin] and "[t]his combination does not meet the claim language stating that '... ambient air will be caused to flow from outside the housing directly into said primary and secondary inlets...'" (brief, pages 17 and 18). We do not agree with the examiner or with the appellant.

For the same reasons explained above with regard to the examiner's proposed combination of Heyl and Ruemelin, we do not find any teaching or suggestion in either Gueyrard or Ruemelin for modifying Gueyrard's apparatus for receiving a poured product by providing Ruemelin's apparatus for dust separation from a current of air therein. For this reason, it is our opinion that the modification proposed by the examiner is based on impermissible hindsight and would not have been obvious to one of ordinary skill in the art. Nevertheless, for reasons similar to those set forth above with regard to Heyl, we find that Gueyrard teaches all of the limitations of appellant's claim 1 and we will affirm the examiner's rejection of claim 1 on this ground. Our affirmance of this rejection is denominated a new ground of rejection under 37 CFR § 1.196(b) for reasons explained infra.

In accordance with 37 CFR § 1.192(c)(7) (1995), we have selected claim 1 as the representative claim from the appellant's grouping (brief, page 10) of claims 1, 2 and 4 through 15 and decide the appeal on this rejection on the

basis of this claim alone. Accordingly, we sustain the examiner's rejection of claims 2 and 4 through 15 under 35 U.S.C. § 103 as well as claim 1.

NEW GROUNDS OF REJECTION

Under the authority of 37 CFR § 1.196(b), this panel of the Board introduces the following new grounds of rejection.

Claim 3 is rejected under 35 U.S.C. § 102(b) as being anticipated by Heyl or Gueyrard. For the reasons noted above, Heyl and Gueyrard both teach all of the limitations of claim 1, and the further recitation in claim 3, which depends from claim 1, of "a plurality of secondary inlets disposed about a periphery of said primary inlet", is satisfied by the secondary openings/inlets at the periphery of Heyl's grate (124) and by the openings/inlets at the periphery of Gueyrard's safety grid (3) which surround the central primary inlet portion.

Inasmuch as the basic thrust of our affirmance of the 35 U.S.C. ' 103 rejections of claim 1 (the 35 U.S.C. § 103

rejection over Heyl taken together with Ruemelin and the 35 U.S.C. § 103 rejection over Gueyrard taken together with Ruemelin) differs from the rationale advanced by the examiner, we hereby designate the affirmance of these two rejections to be new grounds of rejection pursuant to 37 CFR ' 1.196(b) to allow the appellant a fair opportunity to react thereto (see In re Kronig, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976)).

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 2 and 4 through 15 under 35 U.S.C. § 103 as being unpatentable over Heyl taken together with Ruemelin is affirmed, with the affirmance constituting a new ground of rejection under 37 CFR ' 1.196(b); the decision of the examiner to reject claims 1, 2 and 4 through 15 under 35 U.S.C. § 103 as being unpatentable over Oldham taken together with Ruemelin is reversed; the decision of the examiner to reject claims 1, 2 and 4 through 15 under 35 U.S.C. § 103 as being unpatentable over Heyl taken

together with Gueyrard is affirmed, with the affirmance constituting a new ground of rejection under 37 CFR ' 1.196(b), and claim 3 is rejected under 35 U.S.C. § 102(b), the rejection being a new ground of rejection under 37 CFR ' 1.196(b).

This decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63,122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

- (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the

claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

- (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED; 37 CFR § 1.196(b)

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
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)	INTERFERENCES
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APPLICATION NO. 08/932,090

APJ LAZARUS

APJ NASE

APJ FRANKFORT

PART;1.196(b)

DECISION: **AFFIRMED-IN-**

Prepared By: RBL

DRAFT TYPED: 10 Jan 02

FINAL TYPED: